



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,600	01/24/2002	Scott C. Harris	Connect-Net	6414
23844	7590	05/10/2011	EXAMINER	
SCOTT C HARRIS			JACKSON, BLANE J	
Law Office of Scott C Harris, Inc				
P O BOX 1389			ART UNIT	
Rancho Santa Fe, CA 92067-1389			PAPER NUMBER	
			2618	
			NOTIFICATION DATE	
			DELIVERY MODE	
			05/10/2011	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

scott@harrises.com
schuspto@gmail.com

Office Action Summary	Application No. 09/683,600	Applicant(s) HARRIS, SCOTT C.	
	Examiner BLANE J. JACKSON	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15, 17, 18, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17, 18, 27, 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

It was determined in an Appeal Conference to reopen the application with a clarification of the original 35 USC 112 and a rejection on the substance of the claims in view of prior art. Consequently the claims filed 09 March 2010 are addressed in the rejection to follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-15, 17, 18, 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to independent claim 13, the Disclosure indicates “a first electronically operated device” which is not original claim language and the function of which is not identified in the Disclosure. The Specification identifies a system

Art Unit: 2618

comprising at least two devices, a handset (120) and a computer (100) which are networked together to perform call related functions. The claim language appears to combine the functions of these two devices into one, the "first electronically operated device" which confuses the function of the apparatus of the system as described in the Disclosure.

Furthermore, amended claim language with respect to "a second device" of claim 13 is not identified in the Disclosure and renders the claim element unclear. Prior claim language with respect to the associated claim element indicated this apparatus to comprise a networked computer whereas subsequent remarks from the applicant identify this to mean a second handset (130)). The identity and function of "a second device" is necessary for complete prosecution of the claim.

The Specification, see paragraphs 0031 and 0039, does not combine the separate functions claimed in claims 17 and 28 of "wherein text (or a document) indicative of said recognized voice information is displayed on said first electronically operated device" with the function cited in independent claim 13 including "automatically placing a call based on the stored contact information obtained from the recognized voice information". These are two different embodiments of the "first electronically operated device" that are not performed in parallel.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 recites the limitation "said second computer". There is insufficient antecedent basis for this limitation in the claim.

Specification

Dependent claim 28 is objected to since it indicates "said first electronically operated device sends said voice to be recognized over said network and receive a document that includes text. . ." but does not clearly indicate what apparatus on "said network" such as the "second device" and separate from the "first electronically operated device" to receive, produce and send the text. It is suggested the dependency of claim 28 is changed from claim 13 to claim 27.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

Art Unit: 2618

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 13-15, 18 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Beach US 6,901,270.

As to claim 13, Beach teaches a system comprising:

a first electronically operated device, including a telephone function that controls receiving a telephone call (figures 1 and 2, column 3, lines 5-35, mobile device (10) comprising cellular and Bluetooth transceivers for providing voice commands with a remote computer),

said first electronically operated device sensing a first control, and responsive to sensing said first control, creating a synthesized voice that requests information (figure 2, column 3, line 36 to column 4, line 14 and column 5, line 6 to column 6, line 17, the computer generates a synthesized response to the user voice command such as "telephone" which is sent over the wireless local area network to the mobile device),

said first electronically operated device receiving a voice to be recognized responsive to said creating said synthesized voice (column 4, lines 1-14 and column 5, lines 32-63, the computer, comprising a large vocabulary voice recognition system responds to the user voice command with further questions)

said first electronically operated device including a connection to a network that extends between said first electronically operated device and a second device (figure 2,

Art Unit: 2618

column 3, lines 36-58, the mobile device communicates via a wireless node (17) to a local area network comprising computer (15) and PBX (19)),

wherein said first -electronically operated device operates to obtain recognized voice information from said voice to be recognized, said first electronically operated device storing plural different contact information for plural different contacts (column 5, line 47 to column 6, line 17, based on the telephone contact identified by the mobile device user, the computer retrieves the telephone number from storage to initiate a call),

wherein said first electronically operated device compares said recognized voice information against said stored contact information, and recognizes said recognized voice information only as being one of said stored contact information, and controls automatically placing a call based on the stored contact information obtained from the recognized voice information (column 5, line 47 to column 6, line 47, the user provides a contact name or names for the computer to retrieve the telephone or extension number for the call or conference call to other mobile units).

As to claim 14, Beach teaches a system as in claim 13, wherein said first electronically operated device is included within a portable telephone (figure 1, column 3, lines 5-58, a mobile device (10) used for telephone calls based on voice commands).

As to claim 15, Beach teaches a system as in claim 13, wherein said first electronically operated device is included within a personal digital assistant (figure 1, column 5, lines 11-46).

As to claim 18, Beach teaches a system as in claim 13, wherein said network connection is a Bluetooth connection (column 3, lines 6-35).

As to claim 27, Beach teaches a system as in claim 13 further comprising a computer remote form said electronically operated device, said second computer connected to said network and including automatic voice recognition capability (figure 2, column 4, line 63 to column 5, line 63, the computer (15) on the WLAN has a larger vocabulary voice recognition system).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLANE J. JACKSON whose telephone number is (571)272-7890. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blane J. Jackson/
Primary Examiner, Art Unit 2618

/Edward Urban/
Supervisory Patent Examiner, Art Unit 2618